

### **REMARKS**

This responds to the Office Action mailed on June 19, 2006.

Claims 1, 4, 5, 7, 13, 16, 27, 30, 32, 41 and 47 are amended, no additional claims are canceled; no claims are added; as a result, claims 1, 3-22, 24-27, 29-44, 47, 48 and 53-55 are now pending in this application.

The amendments to the claims have been to clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims and new claims have support throughout the specification. No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

### **Interview Summary**

Applicant thanks Examiner Cristina O. Sherr for the courtesy of a telephone interview on September 18, 2006 with Applicant's Representative, Barbara J. Clark. The outstanding rejection under 35 USC 103(a) based on Elander (U.S. Patent No. 4,500,750) in view of French (U.S. Patent No. 6,321,339) was discussed. No specific agreement as to claim language was reached, although Examiner Sherr agreed to consider amendments which recite at least two types of authentication (mechanisms, methods or information). Ms. Clark thanks Examiner Sherr for the courtesies extended during the interview.

### **§103 Rejection of the Claims**

Claims 1, 3-22, 24-27, 29-44, 47, 48 and 53-55 were rejected under 35 USC § 103(a) as being unpatentable over Elander et al. (U.S. 4,500,750) in view of French et al. (U.S. 6,321,339).

The Office Action states that the reference teaches various elements of the claims and that it would be obvious to adapt Elander to obtain the instant invention. The Examiner admits that Elander does not disclose the user or relying party selecting the authentication from the set of authentication mechanisms, wherein a flexible authentication process is provided, but that the user in French is selecting a lower risk transaction. The Examiner concludes that it would be

obvious to combine the teachings of Elander and French to create greater flexibility without sacrificing security. The Applicant respectfully traverses these assertions.

Applicant respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Furthermore, claims 3-6, 8-12, 14-26, 29-40, 42-44, 47, 48 and 53-55 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Elander does not teach or suggest the claimed invention. Elander discusses a cryptographic application for interbank verification which utilizes a fixed verification system of encryption and decryption.

French does not overcome the deficiencies of the primary reference. French uses authentication from a credit bureau database for the purpose of issuing a digital certificate.

In contrast, claims 1 and 7, as amended, recite, in part, “a user or relying party selecting at least two authentication mechanisms . . . to input from [a] set (claims 1 and 13) or selection (claim 7) of authentication mechanisms . . . wherein a flexible authentication process is provided. Also in contrast, claim 27, as amended, recites, in part, “receiving a selection of at least two authentication methods from the at least one user, wherein a flexible authentication process is provided. . .” Also in contrast, claim 41, as amended, recites, in part, “selecting, by the user or the relying party, at least two types of authentication information, wherein a flexible authentication process is provided.”

In any case, the mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. There is simply no teaching or suggestion in Elander *as to the desirability* of providing a flexible authentication process wherein the user or relying party selects at least two authentication mechanisms to input from a set or selection of authentication mechanisms as recited in claims 1, 7 and 13, as amended. Nor is there any teaching or suggestion in Elander *as to the desirability* of providing the elements of claims 27, and 41, as amended. Additionally, motivation to combine the references must come from within the references themselves and cannot be generated by “hindsight or reconstruction.” In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. See *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir.1988). Applicant requests the Office Action to either provide evidence of such motivation or withdraw this rejection.

Applicant respectfully submits that while a court must ascertain the differences between a claimed invention and the prior art, it is not proper to focus on the question of whether any particular difference or differences would have been obvious. Rather, 35 USC 103 requires that the invention be considered “as a whole.” Therefore, even if the references taught or suggested at least two authentication mechanisms as recited in claims 1, 7 and 13, as amended, or at least two authentication methods as recited in claim 27, as amended, or at least two types of authentication information as recited in claim 41, as amended, the invention must be considered as a whole, i.e., such elements must be considered in combination with the other elements of each respective claim. Applicant respectfully submits that when viewed in this manner, it is clear that each claim is patentably distinct from the cited references, either alone or in combination.

Second, there is no reasonable expectation of success. It is also not clear that such modification would be successful, but the mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Applicant requests the Office Action to either provide evidence of such motivation or withdraw this rejection.

An additional requirement of the *prima facie* case is that the references must teach or suggest all the claim limitations. Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. For example, the references do not teach or suggest the user or relying party making the selection as recited in claims 1, 7, 13 and 41, as amended. Although French enables different levels of authentication to be performed based on the level of security desired (see col. 2, lines 62-64), the user is never the one making the selection. The references also do not teach or suggest a method of providing a flexible authentication process which includes relating a type of transaction with a relying party to a level of authentication as recited in claim 1, as amended, or which includes at least one relying party reliant on the authentication service to authenticate the user before user access is provided to its goods or services as recited in claim 7, as amended, or before user access is provided to its service, program or information as in claim 27, as amended, or before the user is allowed to perform the protected service as recited in claim 41, as amended. (Elander utilizes a fixed verification system and French is authenticating for the purpose of issuing a digital certificate). The references also do not teach or suggest producing a portfolio associated with the at least one user, as recited in claim 27, as amended. Applicant assumes the Examiner is taking Official Notice of the missing elements from an undisclosed source. Applicant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Furthermore, a prior-art reference must be considered in its entirety, including portions that teach away from the claimed invention. The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. Stranco Inc. v. Atlantes Chemical Systems, Inc., 15 USPQ2d 1704, 1713 (Tex. 1990). Even if the combination of features found in Elander and French were being claimed, which Applicant respectfully submits they are not, the basic

question is whether the applied references, alone or in any combination, suggest the claimed invention as a solution to the specific problem solved. In the present case, there is no indication of any appreciation of the problem being solved by Applicant's invention which includes, but is not limited to, providing a flexible authentication process which includes a selection of at least two authentication mechanisms being made from among a set or selection of authentication mechanisms or authentication information by a user or relying party as recited in the claims. When a person, having the references before him and not cognizant of Applicant's disclosure, would not be informed that a problem (solved by Applicant's claimed invention) ever existed, such references (which never recognized the problem) *could not have suggested its solution*. In re Shaffer, 229 F.2d 476, 108 USPQ 326, 329 (CCPA 1956). Focusing on the obviousness of substitutions and differences instead of on the invention as a whole is a legally improper way to simplify the difficult determination of obviousness. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81, 93 (Fed. Cir.1986).

Applicant respectfully submits that independent claims 1, 5, 13, 27 and 41 and the claims which depend from them, are patentably distinct from the cited references, either alone or in combination. Claims 1, 3-22, 24-27 and 29-40, 42-44, 47, 48 and 53-55, as amended, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC 103(a). Reconsideration and withdrawal of this rejection is respectfully requested.

#### Claims 3-6

The Office Action states that Elander further discloses the elements of claims 3-6 and that Elander discloses in col. 6, lines 20-65, different authentication mechanisms. The Applicant respectfully traverses these assertions.

The activity described in col. 6, lines 20-65 of Elander pertains to the activity of the authentication server. Additionally, Elander does not teach or suggest a user or relying party selecting at least two authentication mechanisms to input from [a] set of authentication mechanisms according to the level of authentication associated with the type of transaction, wherein a flexible authentication process is provided, as recited in claim 1, as amended.

As claims 3-6 depend from independent claim 1, these claims are also allowable for all the reasons stated herein.

Claims 7-22, 24-27, 29-43 and 53-55

The Office Action states that these claims are rejected based on the same criteria as above. Applicant again traverses this statement for all the reasons stated above. Additionally, claims 8-12 depend on independent claim 7, claims 14-26 depend on independent claim 13, claims 29-40 and 53-55 depend on independent claim 27 and claims 42 and 43 depend on independent claim 41, all of which are allowable for all the reasons stated herein.

Documents Cited But Not Relied Upon For This Office Action

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action, because these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

Conclusion


Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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